

IV. REMARKS

Claims 1-34 are pending in this application. By this amendment, claims 1, 8, 13, 14, 16, 20, 25, 28 and 33 have been amended. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, the drawings are objected to as allegedly not showing every feature of the invention specified in the claims. The specification has been objected to for informalities. Claim 13, 14, 16 and 26 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Claims 13, 14, 16, 26, 33 and 34 are rejected under 35 U.S.C §101 because the invention is allegedly directed to non-statutory subject matter. Claims 1-34 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by either Allen *et al.* (U.S. Patent No. 5,422,821), hereafter "Allen" or Pintsov *et al.* (EP 0710930). Claims 1-34 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Sansone (U.S. Patent No. 6,549,892), hereafter "Sansone."

A. OBJECTION TO THE DRAWINGS

The Office has objected to the drawings because they allegedly do not show every feature of the invention specified in the claims. Specifically, the Office alleges that the drawings do not show editing of the mailing address as claimed in claims 2, 13 and 16. Applicant respectfully traverses the objection. In support, Applicant submits that FIG. 4 shows an edit screen into

which a recipient seeking to electronically edit a previously designated mailing address may edit the address in box 88 (e.g., by changing "123 Smith Lane, Smith, NY 10001" in FIG. 3, box 64 to "456 Jones Lane, Jones, NY 10002" in box 88 of FIG. 4). Applicant submits that the above-specified portions of the figures, among others, show editing of the mailing address as claimed in claims 2, 13 and 16. Accordingly, Applicant requests withdrawal of the objection.

B. OBJECTIONS TO THE DISCLOSURE

The Office has objected to the disclosure because of alleged informalities. First, the Office alleges that the specification lacks a statement of -I claim:--. Applicant has amended page 15 of the disclosure to recite "What is claimed is:". Accordingly, Applicant requests withdrawal of the objection.

The Office also asserts that the subject matter of claims 2, 13 and 16 and the editing of the mailing address lacks antecedent basis within the specification. Applicant respectfully traverses the objection and submits that the following sections, among others, support this claimed feature:

As shown in Fig. 4, edit screen 80 includes recipient name field 82 identifier value field 82, password field 86, mailing address field 88, submit button 90, and cancel button 92. A recipient seeking to electronically edit a previously designated mailing address will do so by entering his/her name into recipient name field 82, assigned identifier value into identifier value field 84, and/94 password into password field 86. Then, the recipient can select the submit button 90. If the entered password, recipient name, and identifier value match, the previously entered mailing address will be retrieved from the database and displayed in mailing address field 88 for editing. Page 9, line 22 through page 10, line 4.

and

In any event, once the mailing address has been accessed, the recipient can edit as desired. As shown, Joe Smith has changed his designated mailing address to "456 Jones Lane, Jones, NY 10002. Page 10, lines 9-11.

To this extent, Applicant submits that the specification contains sufficient antecedent basis for the editing of the mailing address. Accordingly, Applicant respectfully requests that the Office withdraw the objection.

C. REJECTION OF CLAIMS 13, 14, 16 AND 26 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Office has asserted that claims 13, 14, 16 and 26 are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office asserts that the limitation "the sending step" in claim 13 lacks antecedent basis. Applicant has amended claim 13 to recite "...the receiving step." Applicant asserts that this amendment further clarifies the invention. Accordingly, Applicant requests that the rejection be withdrawn.

The Office further states that it is unclear how the machine in claims 14, 16 and 26 can read an identifier associated with the edited mailing address since the identifier is never associated with the edited mailing address. Applicant has amended claims 13 and 16 to recite, "...electronically associating the edited mailing address with the identifier," and claim 25 to recite, "...wherein the recipient interface allows the associated mailing address to be edited and electronically associated with the identifier." Claims 14 and 26 depend from claims 13 and 25, respectively. Applicant asserts that these amendments further clarify the invention. Accordingly, Applicant respectfully requests that the Office's rejection be withdrawn.

D. REJECTION OF CLAIMS 13, 14, 16, 26, 33 AND 34 UNDER 35 U.S.C. §101

The Office has rejected claims 13, 14, 16, 26, 33 and 34 for allegedly being directed to non-statutory subject matter. Specifically, the Office asserts that claims 33 and 34 merely describe an abstract idea of a disembodied storage device that stores a computer program as a non-functional data structure. Applicant has amended claim 33 to recite, "[a] program product stored on a computer usable medium for routing hardcopy mail, the computer useable medium comprising program code for causing a computer system to perform the following steps." Claim 34 depends from claim 33. In addition, the Office states that the steps/actions/functions of claims 13, 14, 16 and 26 are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process. As discussed above with respect to the 35 U.S.C. §112 rejection, Applicant has amended claims 13 and 16 to recite "...electronically associating the edited mailing address with the identifier," and claim 25 to recite "...wherein the recipient interface allows the associated mailing address to be edited and electronically associated with the identifier." Claims 14 and 26 depend from claims 13 and 25, respectively. Applicant asserts that these amendments further direct the invention to statutory subject matter. Accordingly, Applicant requests that the rejection be withdrawn.

E. REJECTION OF CLAIMS 1-34 UNDER 35 U.S.C. §102**1. Rejection of Claims 1-34 Under 35 U.S.C. §102(b) Over Allen**

With regard to the 35 U.S.C. §102(b) rejection over Allen, Applicant asserts that Allen does not teach each and every feature of the claimed invention. For example, with respect to independent claims 1, 8, 16, 20, 28 and 33, Applicant submits that Allen fails to teach

electronically associating a mailing address with the identifier, the mailing address comprising all information necessary for routing the hardcopy mail to a location of the recipient. The invention in Allen reads the name of an addressee and the destination address on a mailpiece and compares the read name and address to a list of names and former addresses of persons who have filed forwarding address information to determine whether a mailpiece has been incorrectly addressed.

Col. 2, lines 28-40. The Allen invention then retrieves a forwarding address along with a corresponding destination (POSTNET) bar code, and applies them to the mailpiece in place of the incorrect address. Col. 4, lines 64-65; FIG. 1. However, the corresponding destination (POSTNET) bar code of Allen is a "...bar code corresponding to the delivery point ZIP code for the forwarding address." Col. 2, line 68 through col. 3, line 1. To this extent, the destination (POSTNET) bar code of Allen simply corresponds to a regional identifier (i.e., ZIP code) and does not comprise all information necessary for routing the mailpiece to the addressee. Nowhere does Allen teach that its destination (POSTNET) bar code is associated with a mailing address that comprises all information necessary for routing the mailpiece to a location of the addressee.

In contrast, the claimed invention includes "...electronically associating a mailing address with the identifier, the mailing address comprising all information necessary for routing the hardcopy mail to a location of the recipient." Claim 1. As such, the identifier of the claimed invention does not merely correspond to a regional identifier as does the destination (POSTNET) bar code in Allen, but instead is associated with a mailing address that comprises all information necessary for routing the hardcopy mail to a location of the recipient. Thus, the identifier of the claimed invention is not taught by the destination (POSTNET) bar code in Allen. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

With further respect to independent claims 1, 8, 16, 20 and 28, Applicant respectfully submits that Allen also fails to teach affixing the identifier to a piece of hardcopy mail in lieu of the mailing address. As stated above, after determining whether a mailpiece has been incorrectly addressed, Allen retrieves a forwarding address along with a corresponding destination (POSTNET) bar code and applies them to the mailpiece in place of the incorrect address. Col. 2, lines 42-45. As such, the destination (POSTNET) bar code of Allen is not applied in lieu of a forwarding address, but rather in addition to the forwarding address. The claimed invention, in contrast, includes "...affixing the identifier to a piece of hardcopy mail in lieu of the mailing address." Claim 1. To this extent, in the current invention, the identifier is affixed to the piece of hardcopy mail in lieu of the mailing address rather than being applied to a mailpiece along with a forwarding address as is the destination (POSTNET) bar code of Allen. For the above reasons, the destination (POSTNET) bar code of Allen does not teach the identifier of the claimed invention. Accordingly, Applicant requests that the rejection be withdrawn.

With respect to dependent claims, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicant submits that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

2. Rejection of Claims 1-34 Under 35 U.S.C. §102(b) Over Pintsov

With regard to the 35 U.S.C. §102(b) rejection over Pintsov, Applicant asserts that Pintsov does not teach each and every feature of the claimed invention. For example, with

respect to independent claims 1, 8, 16, 20, 28 and 33, Applicant submits that Pintsov fails to teach electronically associating a mailing address with the identifier, the mailing address comprising all information necessary for routing the hardcopy mail to a location of the recipient. The invention in Pintsov may print two identifiers on a mailpiece, a unique mailpiece identifier and delivery point destination code. Abstract. However, the unique mailpiece identifier of Pintsov is a postage identifier that also identifies the meter of the sender and therefore has nothing to do with the destination address. Col. 2, lines 55-58. Likewise, the delivery point destination code of Pintsov is merely a zip code, and as such is a regional identifier that does not comprise all information necessary for routing the mailpiece to the addressee. Col. 9, lines 12-26. Nowhere does Pintsov teach that either its unique mailpiece identifier or its delivery point destination code is associated with a mailing address that comprises all information necessary for routing the mailpiece to a location of the addressee.

In contrast, the claimed invention includes "...electronically associating a mailing address with the identifier, the mailing address comprising all information necessary for routing the hardcopy mail to a location of the recipient." Claim 1. As such, the identifier of the claimed invention is not merely a postage identifier or a zip code as are the unique mailpiece identifier and delivery point destination code of Pintsov, but instead is associated with a mailing address that comprises all information necessary for routing the hardcopy mail to a location of the recipient. Thus, the identifier of the claimed invention is not taught by either the unique mailpiece identifier or the delivery point destination code of Pintsov. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

With further respect to independent claims 1, 8, 16, 20 and 28, Applicant respectfully submits that Allen also fails to teach affixing the identifier to a piece of hardcopy mail in lieu of the mailing address. As stated above, the unique mailpiece identifier of Pintsov is printed as part of the postage, and thus, is printed in addition to the mailing address. Col. 2, lines 55-58. Furthermore, the destination delivery code of Pintsov is also printed in addition to the mailing address. Abstract; col. 9, lines 12-26. Nowhere does Pintsov teach an identifier affixed in lieu of the mailing address. The claimed invention, in contrast, includes "...affixing the identifier to a piece of hardcopy mail in lieu of the mailing address." Claim 1. To this extent, in the current invention, the identifier is affixed to the piece of hardcopy mail in lieu of the mailing address rather than being applied to a mailpiece along with a mailing address as are the unique mailpiece identifier and destination delivery code of Pintsov. For the above reasons, the unique mailpiece identifier and destination delivery code of Pintsov do not teach the identifier of the claimed invention. Accordingly, Applicant requests that the rejection be withdrawn.

With respect to dependent claims, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicant submits that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

3. Rejection of Claims 1-34 Under 35 U.S.C. §102(e) Over Sansone

With regard to the 35 U.S.C. §102(e) rejection over Sansone, Applicant asserts that Sansone does not teach each and every feature of the claimed invention. For example, with

respect to independent claims 1, 8, 16, 20, 28 and 33, Applicant submits that Sansone fails to teach affixing the identifier to a piece of hardcopy mail in lieu of the mailing address.

Specifically, Sansone teaches "...allowing individuals or entities to add recipients unique code to the recipient mailing address." Col. 2, lines 29-30. As such, the unique code of Sansone is not applied in lieu of a forwarding address, but rather in addition to the forwarding address. The claimed invention, in contrast, includes "...affixing the identifier to a piece of hardcopy mail in lieu of the mailing address." Claim 1. To this extent, in the current invention, the identifier is affixed to the piece of hardcopy mail in lieu of the mailing address rather than being applied to a mailpiece along with a forwarding address as is the unique code of Sansone. For the above reasons, the unique code of Sansone does not teach the identifier of the claimed invention. Accordingly, Applicant requests that the rejection be withdrawn.

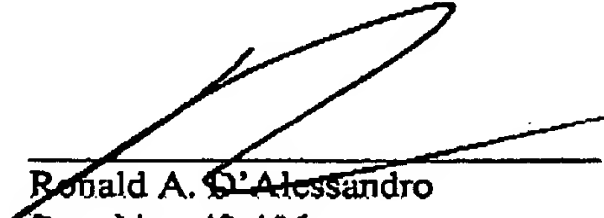
With respect to dependent claims, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicant submits that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

VI. CONCLUSION

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

Date: June 22, 2005


Ronald A. D'Alessandro
Reg. No.: 42,456

Hoffman, Warnick & D'Alessandro LLC
Three E-Comm Square
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)

RAD/hew

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